



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                   | CONFIRMATION NO.       |
|---|-------------|----------------------|---------------------------------------|------------------------|
| 10/784,848  | 02/24/2004  | Peter Gernold        | 13906-184001 /<br>2003P00962          | 9474                   |
| 32864 7590 12/13/2007<br>FISH & RICHARDSON, P.C.<br>PO BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      | EXAMINER<br>ZELASKIEWICZ, CHRYSTINA E |                        |
|   |             |                      | ART UNIT<br>4143                      | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>12/13/2007               | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |   |                                       |  |
|------------------------------|---|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/784,848      | <b>Applicant(s)</b><br>GERNOLD, PETER |  |
|                              | <b>Examiner</b><br>Chrystina Zelaskiewicz | <b>Art Unit</b><br>4143               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :28 November 2006, 5 November 2004, 12 March 2004.

**DETAILED ACTION**

***Status of Claims***

1. This action is in reply to the application filed on 24 February 2004.
2. Claims 1-20 are currently pending and have been examined.

***Priority***

3. Applicant's claim for the benefit of a prior-filed application, 60/478,349, under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

***Information Disclosure Statement***

4. The Information Disclosure Statements filed on 28 November 2006, 5 November 2004, and 12 March 2004 have been considered. An initialed copy of the Form 1449 is enclosed herewith.

***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 300 in Figure 3.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 4143

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 and its dependent claims 2-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is indefinite because it is directed to two categories: *a computer-readable medium **or** propagated signal having embodied thereon a computer program*. With respect to the propagated signal being a statutory category, please see § 101 rejections below.
8. Claim 1 provides for the following intended uses: *a computer program **configured to** receive information; **for use in** generating; one or more code segments **configured to***.
9. Claim 10 provides for the following intended uses: *method **for** receiving; a user **for use in** generating; criterion **for use in** generating*.
10. Claim 19 provides for the following intended uses: *a system **for** receiving information from a user **for use in**; wherein the processor is **configured to**; receive information from a user, **for use in**; one or more code segments **configured to**; and the distribution criterion **for use in***.

However, since claims 1, 10, and 19 do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

#### ***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
12. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in **most cases** since use of technology permits the function of the descriptive material to be realized. See MPEP § 2106.01.

Art Unit: 4143

13. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 is directed to *a computer-readable medium or propagated signal having embodied thereon a computer program*. With respect to the computer-readable medium, claim 1, as currently written, does not have the functional descriptive material (a computer program) as structurally and functionally interrelated to the medium. Instead, claim 1 should be directed to an **executable** computer program that is **tangibly embodied** on a computer readable medium. With respect to the propagated signal, a signal is not a process, machine, manufacture, or composition of matter. Therefore, a signal is not statutory matter under 35 U.S.C. 101.
14. Claims 9 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9 and 18 are directed to *the distribution criterion comprises a computer program that when executed*. Claims 9 and 18, as currently written, do not have the functional descriptive material (a computer program) recorded on some computer-readable medium. Instead, claims 9 and 18 should be directed to an **executable** computer program that is **tangibly embodied** on a computer readable medium.
15. Claims 1, 10, and 19 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).
16. Claim 1 does not set forth any steps in the following intended uses: *a computer program configured to receive information; for use in generating; one or more code segments configured to*.
17. Claim 10 does not set forth any steps in the following intended uses: *method for receiving; a user for use in generating; criterion for use in generating*.
18. Claim 19 does not set forth any steps in the following intended uses: *a system for receiving information from a user for use in; wherein the processor is configured to;*

Art Unit: 4143

*receive information from a user, **for use in**; one or more code segments **configured to**;  
and the distribution criterion **for use in**.*

**Claim Rejections - 35 USC § 102**

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

20. Claims 1-4, 8-13, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Bracho et. al. (US 5,870,605).

**Claims 1, 10, and 19**

Bracho, as shown, discloses the following limitations:

- *receive an input identifying a type of data to be distributed to data sites* (see at least column 8, lines 44-51: The subscriber then registers a "subscription" for the event type that it wishes to receive through the hub. (The subscriber can look at the hub to see what types of events are advertised.) A subscription specifies a **type of event**, and can further specify a "filter" indicating that the subscriber wishes to receive only events of a certain type that also have certain values in certain fields);
- *receive an input identifying a distribution criterion that defines the basis upon which the type of data is to be distributed to the data sites* (see at least column 8, lines 44-51: The subscriber then registers a "subscription" for the event type that it

Art Unit: 4143

wishes to receive through the hub. (The subscriber can look at the hub to see what types of events are advertised.) A subscription specifies a type of event, and can further specify a **"filter"** indicating that the subscriber wishes to receive only events of a certain type that also have certain values in certain fields); and

- *store the type of data to be distributed and the distribution criterion for use in generating data subscriptions in a network of distributed computer systems operating an application program having application data of various data types, wherein the data subscriptions are generated based on the type of data to be distributed to data sites and the distribution criterion* (see at least column 5, lines 34-47: A publisher uses an "advertisement" to tell the system what types of events it intends to publish and how it intends to publish them (e.g., daily, as each event trigger occurs, etc). Advertisements are registered with the hub connected to the publisher during the installation of the publisher. An advertisement must have a unique name. In addition to containing a name of an event type to be published, an advertisement contains other information about the publisher. This information can include the priority level for the published events, **for how long the events are valid**, etc. Hubs transmit advertisements to all potential subscribers. Hubs transmit published events to all subscribers who have subscribed to events of that type, whose content matches the subscriber's subscription).

#### **Claims 2 and 11**

Bracho discloses the limitations of claims 1 and 10 as shown above. Furthermore, Bracho, as shown, discloses the following limitation:

- *the type of data to be distributed to data sites comprises a business object type* (see at least column 6, lines 19-20: an application publishes "SalesOrder" events).

#### **Claims 3 and 12**

Bracho discloses the limitations of claims 1 and 10 as shown above. Furthermore, Bracho, as shown, discloses the following limitation:



Art Unit: 4143

- *the type of data to be distributed to data sites comprises a publication* (see at least column 5, lines 9-11: a "publisher" publishes events of certain types on the network 120 and a "subscriber" subscribes to events of certain types).

#### **Claims 4 and 13**

Bracho discloses the limitations of claims 1 and 10 as shown above. Furthermore, Bracho, as shown, discloses the following limitation:

- *the distribution criterion comprises an attribute of the type of data to be distributed* (see at least column 11, lines 44-52: Event attribute names are used to denote which field in the event should be compared. Sub-fields (those inside structures) are specified using dot notation. Names can also be enumerated types, as is known to persons familiar with the C programming language. Once a content filter has been specified, it is used during event routing as described below in connection with FIGS. 8-12. Information describing each content filter for a subscription is stored in field 774 of FIG. 7).

#### **Claims 8 and 17**

Bracho discloses the limitations of claims 1 and 10 as shown above. Furthermore, Bracho, as shown, discloses the following limitation:

- *the distribution criterion comprises a distribution criterion that identifies two attributes of the type of data to be distributed such that both of the two attributes are required to match the application data to be distributed* (see at least column 7, lines 15-21: An advertisement includes the name of the advertisement, a description of the event that a publisher publishes (e.g., a SalesOrder event), a description of how the publisher publishes its events (e.g., daily, when an event trigger occurs, etc.), the name of the event type, the priority level of the events, and the expiration time on the events).

#### **Claims 9 and 18**

Bracho discloses the limitations of claims 1 and 10 as shown above. Furthermore, Bracho, as shown, discloses the following limitation:

Art Unit: 4143

- *the distribution criterion comprises a computer program that when executed defines a basis upon which the type of data is to be distributed to data sites (see at least column 5, lines 65-67: both publishers and subscribers preferably are implemented as software programs executed by a processor).*

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

23. Claims 5-7, 14-16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bracho as applied to claims 1 and 10 above, and further in view of Cheng et. al. (5,884,324).

**Claims 5, 14, and 20**

Bracho discloses the limitations of claims 1, 10, and 19 as shown above. Furthermore, Cheng, as shown, discloses the following limitation:

- *the distribution criterion comprises a distribution criterion based on a relationship of data with an employee that uses a data site (see at least column 4, lines 7-17: Block 216 represents the data replication agent 102 determining whether the remote user is authorized to access the DBMS 108. If the remote user 100 is not authorized to access the DBMS 108, the data replication agent 102 denies remote user 100 a*

Art Unit: 4143

token, as illustrated in block 218. Data replication agent 102 processing thereafter returns to an idle state 222. If the remote user is authorized to access the DBMS 108, the data replication agent 102 transmits a token from the data replication agent 102 to the remote client 100, as shown in block 220).

It would have been obvious to one skilled in the art at the time of the invention to combine the middleware for enterprise information distribution of Bracho with the agent for replicating data of Cheng. Bracho teaches a method and apparatus for publishing and receiving events to and from a network, but fails to teach using a distribution criterion based on a relationship of data with an employee. However, Cheng teaches using authorization access as a distribution criterion. Therefore, it would have been obvious to combine Bracho with Cheng because only the appropriate subscribers should receive published events on the network (see at least Bracho, column 2, lines 16-20).

#### **Claims 6 and 15**

Bracho discloses the limitations of claims 1 and 10 as shown above. Furthermore, Cheng, as shown, discloses the following limitation:

- *the distribution criterion comprises a distribution criterion based on a responsibility of an employee that uses a data site* (see at least column 4, lines 7-17: Block 216 represents the data replication agent 102 determining whether the remote user is authorized to access the DBMS 108. If the remote user 100 is not authorized to access the DBMS 108, the data replication agent 102 denies remote user 100 a token, as illustrated in block 218. Data replication agent 102 processing thereafter returns to an idle state 222. If the remote user is authorized to access the DBMS 108, the data replication agent 102 transmits a token from the data replication agent 102 to the remote client 100, as shown in block 220).

It would have been obvious to one skilled in the art at the time of the invention to combine the middleware for enterprise information distribution of Bracho with the agent for replicating data of Cheng. Bracho teaches a method and apparatus for publishing and receiving events to and from a network, but fails to teach using a distribution criterion

Art Unit: 4143

based on a responsibility of an employee. However, Cheng teaches using authorization access as a distribution criterion. Therefore, it would have been obvious to combine Bracho with Cheng because only the appropriate subscribers should receive published events on the network (see at least Bracho, column 2, lines 16-20).

**Claims 7 and 16**

Bracho discloses the limitations of claims 1 and 10 as shown above. Furthermore, Cheng, as shown, discloses the following limitation:

- *the distribution criterion comprises a query executable against portions of the application data* (see at least column 4, lines 58-61: Once communications are established, the query result will be sent to and stored at the remote client 100, and the daemon 132 will notify the person making the database request of the query result).

It would have been obvious to one skilled in the art at the time of the invention to combine the middleware for enterprise information distribution of Bracho with the agent for replicating data of Cheng. Bracho teaches a method and apparatus for publishing and receiving events to and from a network, but fails to teach using a distribution criterion comprising a query executable against portions of the application data. However, Cheng teaches using such a query as the distribution criterion. Therefore, it would have been obvious to combine Bracho with Cheng because the ability to store, retrieve, and manage massive amounts of information has become a virtual necessity in business today (see at least Cheng, column 1, lines 14-16).

***Double Patenting***

24. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference

Art Unit: 4143

claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 25.** Claims 1, 10, and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, and 15 of copending Application No. 10784196. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the instant application would have been obvious to one of ordinary skill in the art in light of the disclosure of application 10784196. Claims 1, 7, and 15 of application 10784196 are directed to accessing the type of data to be distributed and the distribution criterion, and generating data subscriptions based upon the type of data and the distribution criteria (see Application No. 10784196 claims 1, 7, and 15). Claims 1, 10, and 19 of the instant application are directed to receiving information from a user for use in generating data subscriptions with steps for the following: receiving data and a distribution criterion; storing distribution criteria and the type of data to be distributed; and for generating data subscriptions based on the type of data to be distributed. The instant application would have been obvious to one of ordinary skill in the art in light of claims 1, 7, and 15 of

Art Unit: 4143

application 10784196 because if the data and distribution criterion can be accessed, then the person of ordinary skill would have received and stored this information in order to generate the data distribution.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 4143

**Conclusion**

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Chrystina Zelaskiewicz** whose telephone number is **571.270.3940**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A. Reagan** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

Randolph Building

401 Dulany Street

Alexandria, VA 22314

/Chrystina Zelaskiewicz/Examiner, Art Unit 4143

December 10, 2007

/James A. Reagan/Supervisory Patent Examiner, Art Unit 3621